

## REMARKS

### **I. Introduction**

Claims 1-8 remain pending in the present application. Claims 1 and 8 have been amended. In view of the preceding amendments and following remarks, it is respectfully submitted that claims 1-8 are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1, 2, 6 and 8 under 35 U.S.C. § 102(b)**

Claims 1, 2, 6 and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,811,671 (“Seekircher”). Applicants respectfully submit that claims 1, 2, 6 and 8 are not anticipated by the applied reference, for at least the reasons set forth below.

To anticipate a claim under § 102(b), a single prior art reference must identically disclose each and every claim element. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claimed element is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, **arranged exactly as in the claim**. Lindeman, 703 F.2d 1458 (Emphasis added). Additionally, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also **enable** a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Applicants have amended claim 1 to further recite that “the single, integrated control unit” is **“formed as a single, discrete structural unit separate from the engine.”** Claim 8 has been amended to recite substantially similar features as the above-recited features of claim 1.

In the “Response to Arguments” section of the Office Action, the Examiner states that “[t]he control units, engine control unit (col. 4, lines 12-16) and testing control unit [of Seekircher] are connected therefore they are integrated and the Examiner is interpreting them to be one single unit.” In support of this interpretation, the Examiner provides an example of a desktop computer, i.e., “desktop computer has many processors inside but the **desktop computer** is still **interpreted as one unit** because all the **processors are integrated** inside of the computer.” However, applying the most generous interpretation of the Examiner’s rationale (i.e., an “integrated unit” is defined by integration of components within an overall housing for the “integrated unit”) to the actual disclosure of Seekircher, the “single, integrated unit” taught by Seekircher would be, at the most, the **overall engine compartment**, since: a) Seekircher clearly teaches that the “engine control unit” is “part of the engine 1” (col. 4, l. 13-14); b) the Examiner is contending that the connection between the testing control unit 9 and the engine control unit defines a “**single, integrated control unit**”; and c) there is absolutely no suggestion in Seekircher that any discrete housing is provided within the overall engine compartment for the combination of the engine control unit and the testing control unit (in fact, Seekircher clearly states that the “**engine control unit . . . is not shown**,” and there is no suggestion of the exact location).

In contrast, the “single integrated unit” recited in present claims 1 and 8 is a “control unit” that is “**formed as a single, discrete structural unit separate from the engine.**” Since Seekircher clearly teaches that the “engine control unit” is “part of the engine 1,” and since there is absolutely no suggestion in Seekircher that any discrete housing is provided within the overall engine compartment for the combination of the engine control unit and the testing control unit, there is simply no way that the teachings of Seekircher can possibly satisfy the claimed limitation that “the **single, integrated control unit**” is “**formed as a single, discrete structural unit separate from the engine.**”

For at least the foregoing reasons, claims 1 and 8, as well as dependent claims 2 and 6, are not anticipated by Seekircher. Withdrawal of the rejection is requested.

### **III. Rejection of Claim 3 under 35 U.S.C. §103(a)**

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,811,671 (“Seekircher”), in view of U.S. Patent No. 6,293,251 (“Hemmerlein”).

Applicants submit that the combination of Seekircher and Hemmerlein fails to render obvious claim 3 for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 3 depends on claim 1. As noted above, Seekircher clearly fails to anticipate parent claim 1. Furthermore, Hemmerlein clearly fails to remedy the deficiencies of Seekircher as applied against parent claim 1. Therefore, the overall teachings of Seekircher and Hemmerlein fail to render obvious claim 1 and its dependent claim 3.

For at least the reasons stated above, claim 3 is patentable over the combination of Seekircher and Hemmerlein. Withdrawal of the rejection of claim 3 is respectfully requested.

#### **IV. Rejection of Claim 4 under 35 U.S.C. § 103(a)**

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,811,671 ("Seekircher"), in view of U.S. Patent No. 5,633,458 ("Pauli"). Applicants submit that the combination of Seekircher and Pauli fails to render obvious claim 4 for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and

not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 4 depends on claim 1. As noted above, Seekircher clearly fails to anticipate parent claim 1. Furthermore, Pauli clearly fails to remedy the deficiencies of Seekircher as applied against parent claim 1. Therefore, the overall teachings of Seekircher and Pauli fail to render obvious claim 1 and its dependent claim 4.

For at least the reasons stated above, claim 4 is patentable over the combination of Seekircher and Pauli. Withdrawal of the rejection of claim 4 is respectfully requested.

**V. Rejection of Claim 5 under 35 U.S.C. § 103(a)**

Claim 5 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,811,671 ("Seekircher"), in view of U.S. Patent No. 6,754,604 ("Weiland"). Applicants submit that the combination of Seekircher and Weiland fails to render obvious claim 5 for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 5 depends on claim 1. As noted above, Seekircher clearly fails to anticipate parent claim 1. Furthermore, Weiland clearly fails to remedy the deficiencies of Seekircher as applied against parent claim 1. Therefore, the overall teachings of Seekircher and Weiland fail to render obvious claim 1 and its dependent claim 5.

For at least the reasons stated above, claim 5 is patentable over the combination of Seekircher and Weiland. Withdrawal of the rejection of claim 5 is respectfully requested.

**VI. Rejection of Claim 7 under 35 U.S.C. § 103(a)**

Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,811,671 ("Seekircher"), in view of U.S. Patent No. 6,085,142 ("Di Leo"). Applicants submit that the combination of Seekircher and Di Leo fails to render obvious claim 7 for at least the following reasons.

In rejecting a claim under 35 U.S.C. §103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 23 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art references must teach or suggest all of the claimed features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 7 depends on claim 1. As noted above, Seekircher clearly fails to anticipate parent claim 1. Furthermore, De Leo clearly fails to remedy the deficiencies of Seekircher as applied against parent claim 1. Therefore, the overall teachings of Seekircher and Di Leo fail to render obvious claim 1 and its dependent claim 7.

For at least the reasons stated above, claim 7 is patentable over the combination of Seekircher and Di Leo. Withdrawal of the rejection of claim 7 is respectfully requested.

**CONCLUSION**

It is therefore respectfully submitted that the pending claims 1-8 are allowable. All issues raised by the Examiner have been addressed, and an early and favorable action on the merits is solicited.

Respectfully submitted,

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